



PATENT  
Attorney Docket No. ADI-005

11-03

#31  
Appeal  
Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Gebhard  
SERIAL NO.: 09/328,749 GROUP NO.: 3728  
FILING DATE: 9-Jun-99 EXAMINER: Anthony D. Stashick  
TITLE: *Torsion System for an Article of Footwear*

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**REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 1.193**

This Reply Brief is submitted in response to the Primary Examiner's Answer mailed August 19, 2003.

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The following is submitted in reply to the Primary Examiner's Answer of August 19, 2003, and addresses each argument set forth in section 11 of the Answer. For consistency, Appellant retains the lettering-numbering scheme used in the Appeal Brief and Examiner's Answer for identifying the arguments, and omits those sections not at issue in the Answer.

### **ARGUMENT**

**I. Claims 1, 8-11, 15-17, 19-21, 24, and 26 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631) in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820).<sup>1</sup>**

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**B. The cited references, alone or in proper combination, do not render claims 1, 8-11, 15-17, 19-21, 24, and 26 obvious and unpatentable under 35 U.S.C. § 103(a).**

1. U.S. Patent No. 4,922,631 to Anderié (issued May 8, 1990).

The Examiner disputes Appellant's characterization of Anderié Figure 6 as depicting the cross section of Anderié Figure 4, stating instead that Figure 6 represents the cross section of Anderié Figure 8. Examiner's Answer, p. 9. Appellant acknowledges that the presence of the "VI" indicator in Figure 8, and the Description of the Drawings (col. 3, ll. 26-27), both support the Examiner's view. Nevertheless, Appellant respectfully submits that, in view of the following disclosure, Figure 6 also depicts the cross section of Figure 4:

...the stiffening element which is generally indicated by reference numeral 109 in FIG. 4 comprises an elongate bar 110 which in practice is for example about 9 cm in length. The two ends 111 and 112 of the bar 110 are terminated by enlarged portions of a circular configuration. The bar 110 is entirely straight and is of the cross-sectional configuration shown in FIG. 6, between the end portions 111 and 112.

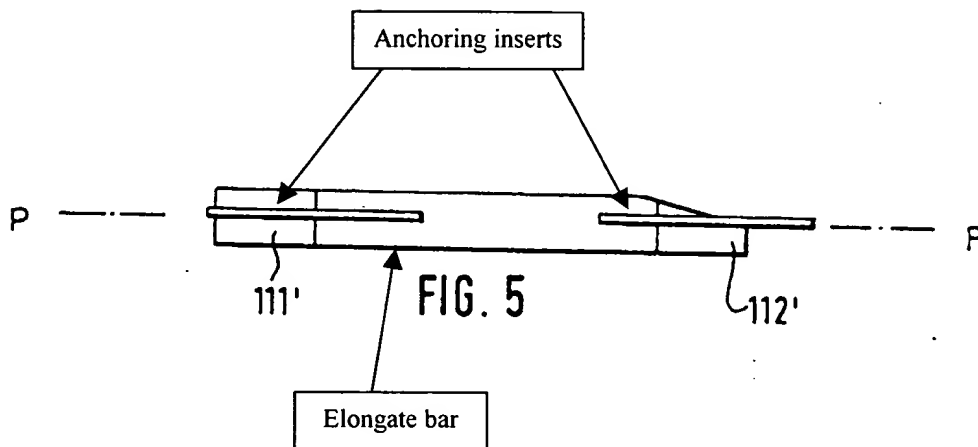
Anderié, col. 5, ll. 9-16 (emphasis added).

The Examiner states that the rectangular portion of Figure 6 annotated on page 10 of the Appeal Brief corresponds to the anchoring insert 119. Examiner's Answer, p. 9. Appellant respectfully disagrees. Anderié Figure 5 is a side view of Figure 4, and there is clear

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<sup>1</sup> As stated in the Appeal Brief, Appellant canceled claim 5 in the Amendment and Response filed October 23, 2002. Appellant is not appealing claim 6. Accordingly, claims 5 and 6 are not discussed.

correspondence between these Figures regarding the extent of the anchoring inserts. Figure 5 clearly shows that the anchoring inserts are embedded in the elongate bar 110:



Appellant's interpretation of Figure 5 is supported by the disclosure that the line P-P represents a plane that is substantially coplanar with the lower surface of the anchoring inserts. Col. 8, ll. 29-32. Further evidence that the rectangular portion of Figure 6 circumscribes the anchoring insert 119 is found in the disclosure where the latter has a thickness of 1 mm, while the height of the limb portions 114, 115 and annular walls 111', 112' is greater, at about 8 mm. Col. 5, ll. 40-49.

In view of the above, the rectangular portion of Figure 6 annotated on page 10 of the Appeal Brief cannot be the anchoring insert as the Examiner asserts, because the anchoring inserts are embedded in the elongate bar, meaning the perimeter of the elongate bar extends beyond the perimeter of the anchoring inserts. In cross section, the outermost perimeter – that of the elongate bar – is shown. Therefore, the rectangular outline of Figure 6 is the surface of the elongate bar, and the limb portions 114, 115, 116 are shown not to extend beyond this surface. While Figure 6 depicts that the limb portions 114, 115 extend beyond the flat portion 113, the flat portion 113 is clearly internal to the elongate bar 110 (i.e., within the rectangular outline). Anderié also states that, while the limb portions 114, 115 extend beyond the flat portion 113, this is not a requirement. Col. 8, ll. 13-24.

In view of the above, Appellant respectfully submits that Anderié neither teaches nor suggests that a rib projects beyond an adjacent surface of the torsion system, as Appellant claims.

4. The cited references, alone or in proper combination, do not render claim 1 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that Dubner “was used to teach that a supportive insole can span substantially the entire forefoot area,” notwithstanding Dubner’s focus on maintaining the wearer’s foot in a selected position. Examiner’s Answer, p. 10. Appellant respectfully submits that this reasoning is flawed because (i) it ignores the express teaching of Dubner with respect to the extent of a supportive insole, and (ii) it ignores that Dubner teaches away from promoting flexibility, which is the goal of the Anderié and Kraeuter et al. references that the Examiner combined with Dubner.

As to the first issue, Dubner expressly requires that the supportive innersole terminate at “the general area of the ball of the foot” and not “under it.” Dubner, col. 5, l. 5; col. 6, ll. 29-30, 43-45; col. 7, l. 42 – col. 8, l. 1. Dubner, in fact, teaches a structure “to prevent the front end of the envelope 26 being pushed under the ball of the foot.” Col. 6, ll. 29-30. As shown in Dubner Figures 10 and 11, for example, this “general area of the ball of the foot” represents only a portion of Appellant’s claimed entire forefoot area of the sole, and is clearly posterior to Appellant’s claimed toe area. In view of this unambiguous disclosure, Appellant respectfully submits that Dubner does not teach and, in actuality, teaches away from, a supportive innersole extending to (or into) a toe area. The Examiner’s statement that Dubner “teaches the claimed area” (Examiner’s Answer, p. 11) is in direct opposition to the express disclosure in Dubner and wholly mischaracterizes the reference.

Regarding the second issue, the Examiner’s reliance on Dubner necessarily implicates all elements of the reference, not just an extent of the supportive innersole. The Examiner cannot look to Dubner for only one feature. Prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention – one cannot pick and choose among individual parts of assorted prior art references “as a mosaic to recreate a facsimile of the claimed invention.” *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 U.S.P.Q.2d (BNA) 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). Consequently, and as discussed in the Appeal Brief, the Dubner reference, directed to a rigid shoe construction for restraining the position of a wearer’s foot, cannot be combined

properly with the Anderié and Kraeuter et al. references that are concerned with promoting or maintaining a flexible shoe.

The Examiner states that Kraeuter et al. is applied to Anderié with respect to “the idea of allowing twisting” and is “irrespective of the flexing.” Examiner’s Answer, p. 11. By this statement, the Examiner admits he has selected an isolated disclosure in the prior art without considering those other aspects in the reference that, as discussed in the Appeal Brief, teach away from the proposed combination of references.

Appellant respectfully submits that, by the Examiner’s own admission, the Examiner has engaged in impermissible hindsight reconstruction. Using Appellant’s claimed invention as a template, the Examiner has pieced together the teachings of the prior art in an attempt to render Appellant’s claimed invention obvious. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1600 (Fed. Cir. 1988)). As discussed in the Appeal Brief, Appellant respectfully submits that a person of ordinary skill would not seek to combine the Anderié, Dubner, and Kraeuter et al. references given their contrary objectives. Consequently, Appellant’s claim 1 is not rendered obvious in view of these references.

5. The cited references, alone or in proper combination, do not render claim 8 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that the areas between the Anderié limb portions 114, 115, 116 depicted in Anderié Figure 6 are apertures formed in the rearfoot portion of the torsion system. Examiner’s Answer, p. 12. Appellant respectfully disagrees. As discussed above, Anderié Figure 6 clearly shows that the limb portions 114, 115, 116 do not extend beyond the surface of the elongate bar 110. This surface is the rectangular outline shown in Figure 6 as annotated in the Appeal Brief. In other words, the limb portions 114, 115, 116 are internal to the elongate bar 110, and the areas between the limb portions 114, 115, 116 represent a variation of the profile of this internal structure. Since the limb portions 114, 115, 116 are internal to the elongate bar 110, they cannot define apertures (i.e., “holes” in the ordinary meaning of the term) in the latter.

Notwithstanding the above, the instant rejection is based on the combination of Anderié, Dubner, and Kraeuter et al. Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 8 obvious.

6. The cited references, alone or in proper combination, do not render claim 9 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that all portions of the Anderié stiffening unit would be fastened together to function as a single unit, thereby meeting the single plate limitation of Appellant's claim 9. Examiner's Answer, p. 12.

The instant rejection is based on the combination of Anderié, Dubner, and Kraeuter et al. Appellant respectfully submits that the Examiner's statements in the Answer regarding Anderié alone are insufficient to justify a combination of these references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 9 obvious.

7. The cited references, alone or in proper combination, do not render claim 10 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that the extension of the Anderié limb portions 114, 115 beyond the flat strip portion 113 aids in preventing bending of the "plate portion 113" in a horizontal plane. Examiner's Answer, p. 13.

The instant rejection is based on the combination of Anderié, Dubner, and Kraeuter et al. Appellant respectfully submits that the Examiner's statements in the Answer regarding Anderié alone are insufficient to justify a combination of these references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 10 obvious.

8. The cited references, alone or in proper combination, do not render claim 11 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that that the height of one embodiment disclosed in Anderié is within the range that Appellant claims (1-15 mm). Examiner's Answer, pp. 13-14.

Nevertheless, as discussed in the Appeal Brief, the issue is the propriety of combining the Dubner, Anderié, and Kraeuter et al. references. The Examiner's statements in the Answer regarding Anderié do not address the constrained thicknesses taught by Anderié, and Kraeuter et al. as opposed to the unconstrained thickness taught by Dubner. Appellant respectfully submits that the Examiner's statements that pertain to Anderié alone and are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 11 obvious.

9. The cited references, alone or in proper combination, do not render claim 15 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that the intermediate portion of Anderié is narrower than the "end plates 118, 119." Examiner's Answer, p. 14.

The issue is not what one reference, in isolation, teaches. The instant rejection is based on a combination of the Anderié, Dubner, and Kraeuter et al. references. As discussed in the Appeal Brief, the cited references teach away from each other with respect to the width of the intermediate portion relative to the rearfoot portion. Appellant respectfully submits that the Examiner's statements that pertain to Anderié alone and are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 15 obvious.

10. The cited references, alone or in proper combination, do not render claims 16, 17, and 19 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that Anderié discloses the claimed materials. Examiner's Answer, pp. 14-15. As addressed in the Appeal Brief, Appellant does not deny that Anderié discloses plastic wires 91 that may be constructed from nylon and a stiffening element 109 that may be a composite body. Appeal Brief, p. 22 (citing Anderié, col. 4, l. 7; col. 8, ll. 41-42).

By focusing solely on one element (the material type) of Anderié, the Examiner fails to consider how Anderié, as a whole, teaches away from the claimed invention and the other cited



references, Dubner and Kraeuter et al., as required by *Akzo N.V.* Further, Appellant respectfully submits that the Examiner's statements in the Answer regarding Anderié alone are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claims 16, 17, and 19 obvious.

11. The cited references, alone or in proper combination, do not render claim 20 unpatentable under 35 U.S.C. § 103(a).

In referring to col. 8, ll. 44-49 of Anderié, the Examiner states that the "end plates" 118, 119 are made of harder plastic material than the stiffening element 109. Examiner's Answer, p. 15. Appellant respectfully submits that the Examiner has mischaracterized the Anderié reference.

As discussed in the Appeal Brief, Anderié discloses that the hardness of the plastic material above the plane P-P is different from the hardness of the plastic material below the plane P-P. Anderié, col. 8, ll. 35-41. Anderié neither teaches nor suggests any variation in hardness along the longitudinal axis T. Consequently, if the anchoring inserts 118, 119 are above the plane P-P, their hardness is the same as that part of the stiffening element 109 above the plane P-P. If, as the Examiner states, the upper surface of the anchoring inserts 118, 119 is coplanar with P-P, then the anchoring inserts 118, 119 are below P-P, meaning their hardness is the same as that part of the stiffening element 109 below P-P.

Although Anderié teaches that the anchoring inserts 118, 119 may be made of harder plastics, the disclosure clearly indicates that this is based on their position above or below, not along, the plane P-P. Col. 8, ll. 41-49. Since the plastic material on either side of the plane P-P spans across the forefoot, intermediate, and rearfoot portions, Anderié neither teaches nor suggests that there are different material properties between these portions, as required by Appellant's claim 20.

Appellant notes that the part of the Anderié reference that the Examiner excerpted in the Answer may include a typographical error. Specifically, the word "upper" at col. 8, l. 46 should arguably be "lower." This provides consistency with the term "lower" at col. 8, l. 31, the

introductory phrase “As stated above” at col. 8, l. 45, and the referenced Figure 5. The typographical error is also evidenced by the disclosure that the region above P-P is constructed from harder plastics, so if the anchoring inserts 118, 119 were in the this region (i.e., making their lower surface coplanar with P-P as shown in Figure 5), then the anchoring inserts 118, 119 would have the hardness as described at col. 8, ll. 45-49. Nevertheless, these inconsistencies in the Anderié reference do not affect Appellant’s contention that, as discussed in the Appeal Brief and mentioned above, Anderié neither teaches nor suggests that there are different material properties between the forefoot, intermediate, and rearfoot portions.

Lastly, the instant rejection is based on a combination of the Anderié, Dubner, and Kraeuter et al. references. As discussed in the Appeal Brief, the cited references teach away from each other with respect to the differing material properties between the forefoot, intermediate, and rearfoot portions. Appellant respectfully submits that the Examiner’s statements that pertain to Anderié alone and are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant’s claim 20 obvious.

12. The cited references, alone or in proper combination, do not render claim 21 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that Appellant’s limitation of a cycling shoe does not distinguish the claim over any other shoe that can be used to pedal a bicycle. Examiner’s Answer, p. 16.

Professional cycling, like many other activities, employs specialized footwear because of the distinctive needs of the participant. To conclude that Appellant’s claimed cycling shoe is indistinguishable from “any shoe” suggests that the Examiner has failed to appreciate that the disclosure in the instant application details the unique requirements of a cycling shoe compared to “any other shoe that can be used to pedal a bicycle.” For example, the claimed cycling shoe includes a torsion system that governs the twisting of the shoe to control knee looping during the pedaling action. Specification, p. 2, ll. 4-16. One reason to minimize knee looping is to avoid fatigue and injuries due to repetitive pedaling. *Id.* The features of the claimed cycling shoe are a result of the specialized biomechanical needs of a cyclist, and they would not be present in “any shoe” unless that shoe was also designed for cycling.

In response to Appellant's remaining arguments regarding claim 21, the Examiner refers to his response regarding Appellant's arguments pertaining to claim 1. Nevertheless, in doing so, the Examiner has failed to demonstrate that the Anderié, Dubner, and Kraeuter et al. references may be combined properly in view of *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. (BNA) 481, 488-89 (Fed. Cir. 1984). Appellant discussed the rule of *Lindemann* in the Appeal Brief, and will not repeat the argument here.

With respect to Appellant's other arguments raised in the Appeal Brief regarding claim 21, Appellant respectfully states that the Examiner has failed to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 21 obvious.

13. The cited references, alone or in proper combination, do not render claim 24 unpatentable under 35 U.S.C. § 103(a).

The Examiner states that Anderié discloses the claimed outsole. Examiner's Answer, p. 16. As addressed in the Appeal Brief, Appellant does not deny that Anderié discloses an outsole. Appeal Brief, p. 27 (citing Anderié, col. 3, ll. 51-65).

As shown in the Answer, the Examiner is, once again, considering an element of Anderié (the outsole) in isolation and not reading the reference as a whole and in connection with the other cited references, Dubner and Kraeuter et al. As discussed in the Appeal Brief, these references cannot be combined properly with respect to the outsole. For example, an object of Kraeuter et al. is "to eliminate the need for an outsole...that span[s] substantially the entire length of the shoe." Kraeuter et al., col. 2, ll. 4-7. Consequently, Kraeuter et al. clearly teaches away from the claimed outsole.

By focusing solely on one element (the outsole) of Anderié, the Examiner fails to consider how Anderié, as a whole, teaches away from the claimed invention and the other cited references, Dubner and Kraeuter et al., as required by *Akzo N.V.* Further, Appellant respectfully submits that the Examiner's statements in the Answer regarding Anderié alone are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant

respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 24 obvious.

14. The cited references, alone or in proper combination, do not render claim 26 unpatentable under 35 U.S.C. § 103(a).

In response to Appellant's arguments pertaining to claim 26, the Examiner applies the Answer given regarding claim 1. As stated in the Appeal Brief, Appellant's claim 26 is similar to claim 1, with a difference being that the forefoot and rearfoot portions of the torsion system are not required to span substantially the entire forefoot and rearfoot areas, respectively, of the sole.

As discussed in the Appeal Brief, and above in connection with claim 1, the Anderié, Dubner, and Kraeuter et al. references cannot be combined properly given the degree to which they teach away from each other and in view of *Akzo N.V.* With respect to claim 1, Appellant asserts above that the Examiner has engaged in hindsight reconstruction, thereby violating the rule of *In re Fritch*. By applying the same analysis here, the Examiner has likewise engaged in impermissible hindsight reconstruction regarding claim 26.

As discussed in the Appeal Brief, and in view of their contrary objectives, Appellant respectfully submits that the Anderié, Dubner, and Kraeuter et al. references cannot be combined properly to render Appellant's claim 26 obvious.

**II. Claims 23 and 25 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631) in view of Dubner (U.S. Patent No. 3,903,621) and Krauter et al. (U.S. Patent No. 5,915,820), in further view of Nagano et al. (U.S. Patent No. 5,446,977).**

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**A. The cited references, alone or in proper combination, do not render claims 23 and 25 obvious and unpatentable under 35 U.S.C. § 103(a).**

2. The cited references, alone or in proper combination, do not render claims 23 and 25 unpatentable under 35 U.S.C. § 103(a).

With respect to claim 23, the Examiner states that Nagano et al. is used to teach an upper and, since Nagano et al. and Anderié implicate a sports shoe, these references may be combined properly. Examiner's Answer, p. 17. Appellant respectfully disagrees.

The rejection of claim 23 is based on the combination of the Anderié, Dubner, Krauter et al., and Nagano et al. references. Prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention – one cannot pick and choose among individual parts of assorted prior art references “as a mosaic to recreate a facsimile of the claimed invention.” *Akzo N.V.*, 1 USPQ 2d at 1246. Accordingly, the Examiner is not free to rely on isolated portions of the references to support the rejection. Rather, the Examiner must consider all aspects of these references and pay particular attention where these aspects teach away from each other or the claimed invention.

Nagano et al., like Anderié and Dubner, includes a structure that resists bending or flexing. This contrasts with Krauter et al., which teaches a structure that promotes bending or flexing. Accordingly, and as discussed in the Appeal Brief, the combination of these references is improper. The Examiner's statement that “Nagano et al. is used to teach an upper” indicates that the Examiner has focused on an isolated element (the upper) of Nagano et al., not the reference in its entirety, to support the rejection. This is improper in view of *Akzo N.V.* Further, the Examiner fails to provide justification for the combination of the references in view of their divergent bending-flexing attributes.

With respect to claim 25, the Examiner states that the cleat of Nagano et al. was not to be used in Krauter et al. The Examiner also states that Krauter et al. was used to teach concavity

but not flexibility. Once again, the Examiner is isolating an element (concavity) of Kraeuter et al. and not considering the reference in its entirety. Further, the Examiner contends that elements of Nagano et al. and Kraeuter et al. (the cleat and flexibility attribute, respectively) are not included in the combination used to support the rejection. This is wholly improper. The instant rejection is based on a combination of four references that must be considered in their entirety. Merging all attributes of Nagano et al. with Kraeuter et al., Anderié, and Dubner will, as discussed in the Appeal Brief, result in an inoperative device. Appellant can rightly rebut the proposed combination of references by demonstrating that aspects of the references (e.g., the Nagano et al. cleat and the Dubner envelope), when combined, result in an inoperative device.

Appellant respectfully submits that the Examiner's statements in the Answer regarding Nagano et al. and Kraeuter et al. are insufficient to justify a combination of the four references cited to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claims 23 and 25 obvious.

**III. Claims 2-4, 11-14, and 18 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631), in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820).**

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**A. The cited references, alone or in proper combination, do not render claims 2-4, 11-14, and 18 obvious and unpatentable under 35 U.S.C. § 103(a).**

**1. The cited references, alone or in proper combination, do not render claims 2-4 unpatentable under 35 U.S.C. § 103(a).**

The Examiner states that twisting of a "plate" is due to applied torsional loads and that the amount of twisting (i.e., angle of rotation) may be determined by testing different loads on the plate. Examiner's Answer, p. 18. Appellant respectfully disagrees.

An object twists about an axis (the axis of rotation) when the object is subjected to a moment (i.e., torque) about that axis. The moment is a function of the applied force and the displacement between the applied force and the axis. The angle of rotation is due to the moment and other factors, such as material properties. The object can include torsion control structures

that can increase or decrease the angle of rotation for a given moment depending on design or application needs. Consequently, there are many factors that influence the angle of rotation in addition to the “torsional loads” referred to by the Examiner in the Answer. By stating that the angle of rotation “can be found by testing different loads on the plate,” the Examiner misapprehends the complexity of the claimed invention. Relating the angle of rotation to the applied force requires consideration of many factors, not just the applied force.

The Examiner further states that, from Anderié, “one can find which twisting angle...would best aid the foot...” *Id.* The Examiner offers no support for this assertion. As discussed in the Appeal Brief, Anderié neither teaches nor suggests an angular range for twisting. The remaining references either teach away from allowing rotation (Dubner) or teach non-torsional flexing (Kraeuter et al.). Appellant respectfully submits that the Examiner’s statements in the Answer that pertain to Anderié alone and are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant’s claims 2-4 obvious.

2. The cited references, alone or in proper combination, do not render claims 11-14 unpatentable under 35 U.S.C. § 103(a).

With respect to claims 11-13, the Examiner states that Anderié discloses a height (8 mm) that is within the ranges that Appellant claims. Examiner’s Answer, p. 19. Nevertheless, as discussed in the Appeal Brief, the issue is the propriety of combining the Anderié, Dubner, and Kraeuter et al. references. The Examiner’s statements in the Answer regarding Anderié do not address the constrained thicknesses taught by Anderié, and Kraeuter et al. as opposed to the unconstrained thickness taught by Dubner. Appellant respectfully submits that the Examiner’s statements in the Answer that pertain to Anderié alone are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant’s claims 11-13 obvious.

With respect to claim 14, the Examiner refers to Anderié Figures 1 and 8 to contend that the Anderié intermediate portion is thinner than the forefoot or rearfoot portions. *Id.* Appellant

respectfully disagrees. These Figures are plan views that disclose width, not thickness. It is Anderié Figure 6, a cross section, which discloses the thickness of an intermediate portion of the stiffening element 109.

In connection with claim 1, the Examiner asserted that the outer rectangle of Anderié Figure 6 corresponds to the anchoring insert 119. Examiner's Answer, p. 9. As discussed above, Appellant disagrees with this contention. Nevertheless, taking this to be the Examiner's view, Figure 6 clearly shows that the thickness of the elongate bar 110 is the same as the thickness of what the Examiner contends is the anchoring insert 119. Consequently, in the Answer, the Examiner has asserted contradictory positions with respect to the thickness of the intermediate portion relative to the forefoot or rearfoot portions.

Further, and as discussed in the Appeal Brief, Anderié discloses that the diameter of the plastic wires 91 (e.g., in the intermediate portion) is greater than the thickness of the anchoring inserts 118, 119 (e.g., in the forefoot and rearfoot portions). Col. 4, ll. 10-12; col. 5, ll. 48-49. The remaining references, discussed in the Appeal Brief, fail to teach or disclosed Appellant's claimed thickness relationship between the intermediate portion and the forefoot and rearfoot portions.

Lastly, the instant rejection is based on a combination of the Anderié, Dubner, and Kraeuter et al. references. Appellant respectfully submits that the Examiner's statements in the Answer that pertain to Anderié alone are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 14 obvious.

3. The cited references, alone or in proper combination, do not render claim 18 unpatentable under 35 U.S.C. § 103(a).

In response to Appellant's claim of a graphite torsion system, the Examiner states that "it would be with [sic] the skill of one of ordinary skill in the art to find a material that would perform the desired rotation..." Examiner's Answer, p. 19. As discussed in the Appeal Brief, none of the cited references teach or disclose the use of graphite. In the Answer, the Examiner



does not refute this argument and fails to cite any reference to support the rejection; the Examiner simply relies on the general skill in the art. This is improper for, as stated by Federal Circuit,

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

*W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303, 312–13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Without a proper citation to a reference of record, the Examiner cannot support the instant rejection. If, by the statements in the Answer, the Examiner wishes to rely on personal knowledge to support the instant rejection, an affidavit under 37 C.F.R. § 1.104(d)(2) with the details thereof is appropriate.

**IV. Claim 7 constitutes nonobvious subject matter and is patentable over Anderié (U.S. Patent No. 4,922,631), in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820), in further view of Eisenbach et al. (U.S. Patent No. 4,815,222).**

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**A. The cited references, alone or in proper combination, do not render claim 7 obvious and unpatentable under 35 U.S.C. § 103(a).**

**2. The cited references, alone or in proper combination, do not render claim 7 unpatentable under 35 U.S.C. § 103(a).**

The Examiner states that Eisenbach et al. “clearly teaches that the intermediate portion of a cycling shoe outsole plate 12 can have a circumscribed aperture 24 located in the intermediate portion thereof...” Examiner’s Answer, p. 20.

As shown in the Answer, the Examiner is, once again, considering an element in the reference (the Eisenbach et al. mounting groove 24) in isolation and not reading the reference as a whole and in connection with the other cited references, Anderié, Dubner, and Kraeuter et al. As discussed in the Appeal Brief, these references cannot be combined properly with respect to the claimed circumscribed aperture. For example, the cited references teach away from each other with respect to the rotation of the forefoot relative to the rearfoot. Appellant respectfully

submits that the Examiner's statements that pertain to Eisenbach et al. alone are insufficient to justify a combination of the cited references to support the rejection. Accordingly, Appellant respectfully submits that, as discussed in the Appeal Brief, these references cannot be combined properly to render Appellant's claim 7 obvious.

## CONCLUSION

Throughout the lengthy prosecution of Appellant's application, the Examiner has issued several rejections under 35 U.S.C. § 103(a). These rejections, despite appearing in six different Office Actions beginning in June 2000, are similar in their structure and content to those rejections now at issue in this appeal.

Appellant's careful review of the Examiner's Answer has revealed, with clarity not seen during the prosecution, the methodology that the Examiner has employed to craft the rejections. Appellant respectfully submits that the Examiner's methodology fails to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), at least because the Examiner does not provide adequate justification of a suggestion to combine or modify the cited references. As discussed above, the Examiner, by his own admission, is given to highlighting one or a limited number of elements that are disclosed in a reference. The Examiner typically does this for each reference included in a rejection under 35 U.S.C. § 103(a), asserting that the highlighted elements correspond to those in Appellant's claims. The Examiner then states that combination of the references renders Appellant's claims obvious. In other words, the Examiner's methodology generally involves assembling references that, in the Examiner's view, show all of the elements in Appellant's claims when the references are combined.

Appellant respectfully submits that the Examiner's methodology is wholly improper for a number of reasons. First, it is classic hindsight reconstruction. As discussed above, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784. Appellant recognizes that reconstruction is permissible, but only under certain conditions. *See, e.g., In re McLaughlin*, 170 U.S.P.Q. (BNA) 209, 212 (C.C.P.A. 1971). Reconstruction is improper when it does not rely only on the knowledge of a person of ordinary skill. *Id.* Throughout the prosecution, in the Appeal Brief, and in this Reply Brief, Appellant has argued that that a person of ordinary skill would not seek to combine the cited references because, for example, the references have incompatible attributes and contrary objectives. The record shows that the Examiner has repeatedly (i) expressed a lack of understanding of this fundamental analysis of the suggestion to combine or modify, and (ii)

provided no substantive rebuttal of Appellant's arguments other than to restate that the combination of the cited references that purportedly show, in the aggregate, the elements in Appellant's claims.

The Examiner's reconstruction is flawed because it does not rely only on the knowledge of a person of ordinary skill, since a person of ordinary skill would not seek to combine the cited references for the reasons that Appellant cites. Instead, the knowledge required flows from Appellant's disclosure, meaning the Examiner's reasoning cannot support rejections under 35 U.S.C. § 103(a).

The Examiner's methodology is also improper because, as discussed above, it isolates one or more elements in a cited reference from the remainder of the disclosure. It is undisputed that prior art references must be read as a whole. *See, e.g., Akzo N.V.*, 1 U.S.P.Q.2d at 1246, *In re McLaughlin*, 170 U.S.P.Q. at 212. By isolating elements in the cited references, the Examiner's methodology fails to consider how all of the elements in the references teach away from each other, the claimed invention, or both. Consequently, the combination of references that the Examiner proposes is actually a combination of isolated elements from each reference. The result is a montage of elements that shows no deference to the incompatible attributes and contrary objectives of the references. This is insufficient to support rejections under 35 U.S.C. § 103(a). *Akzo N.V.*, 1 U.S.P.Q.2d at 1246.

In view of the discussion above, Appellant respectfully submits that claims 1-4, 7-21, and 23-26 are patentable in view of the cited references. Appellant urges the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of these claims.

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Respectfully submitted,



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Attorney Docket No. **PATENT**  
**ADI-005**  
(257/10)

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3728

#31

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: **Gebhard**  
SERIAL NO.: **09/328,749** GROUP NO.: **3728**  
FILING DATE: **June 9, 1999** EXAMINER: **Anthony D. Stashick**  
TITLE: **TORSION SYSTEM FOR AN ARTICLE OF FOOTWEAR**

**CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8**

I hereby certify that this correspondence, and any documents referred to as enclosed herein, are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to **Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450** on this **20th** day of **October, 2003**.

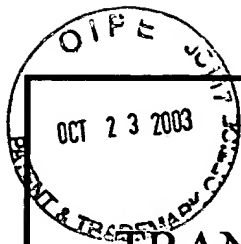
  
Betty B. Leveriza

Mail Stop Appeal Brief - Patents  
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Sir/Madam:

Submitted are the following:

- (1) Transmittal Form (1 pg.);
- (2) Reply Brief (in triplicate) (20 pgs.); and
- (3) a return receipt postcard.



# TRANSMITTAL FORM

Application Serial Number	09/328,749
Filing Date	9-Jun-99
First Named Inventor	GEBHARD
Group Art Unit	3728
Examiner Name	Anthony D. Stashick
Attorney Docket No.	ADI-005
BATCH NO. (after allowance)	N/A
Patent No.	N/A
Issue Date	N/A

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OCT 28 2003

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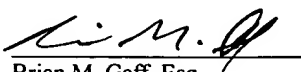
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